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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,163	03/04/2002	Kathleen Hickey Wallis	530057-332	6026

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,163

Applicant(s)

WALLIS, KATHLEEN HICKEY

Examiner

Jila M Mohandesi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-30 are, drawn to a foldable case, classified in class 206.
- II. Claims 31-37, drawn to method of manufacturing a foldable case, classified in class 53.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the foldable case can be made from a different material other than a moldable thermoplastic material.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Applicant's attorney Mr. Berman on December 09, 2003 a provisional election was made with traverse to prosecute the invention of I, claims 1-30. Affirmation of this election must be made by applicant in

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replying to this Office action. Claims 31-37 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

5. Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 25 is the exact duplicate of claim 24.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the meshed screen must be shown or the feature canceled from the claim 11. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 13, 14, 17-18, 21, 23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanco (5,839,575). Blanco '575 discloses a foldable case (10) for displaying an object (booklet 80, floppy disk 84, compact disk 82), the case comprising: first and second case sections joined by a flexible spine (binding member 14) to form an integral body, at least one of the first and second case sections (tray 18 and tray 20) having a well for receiving an object such that the case sections can be foldably closed with the object inside; the flexible spine permitting a first turning action to the first case section along an axis generally parallel to a first major side of the flexible spine; the flexible spine permitting a second turning action to the second case section along an axis generally parallel to the second major side of the flexible spine; a cutout portion in the first case section; and an at least partially transparent window (viewing window 86) attached over the cut out portion on the first case section. See Figure 2 embodiment and column 2, lines 58-63.

The folding case of Blanco '575 is inherently capable of storing a toy.

9. Claims 1-10 and 12-14 and 17-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Weavers (5,568,863). Weavers '863 discloses a foldable case (10) for displaying an object (cassette 26), the case comprising: first and second case sections joined by a flexible spine (spine 18) to form an integral body, the first and second case sections (base 12 & cover 14) each having a well for receiving an object such that the case sections can be foldably closed with the object inside; the flexible spine permitting a first turning action to the first case section along an axis generally parallel to a first major side of the flexible spine; the flexible spine permitting a second turning action to

the second case section along an axis generally parallel to the second major side of the flexible spine; a cutout portion in the first case section and/or second case section; and an at least partially transparent window attached over the cut out portion on the first and/or second case section. See Figures 2 and 3 embodiments and column 2, lines 58-63 and column 3, lines 29-34 and column lines 3-7.

With respect to claims 8-9 note the transparent window (transparent external pocket wrap 28) attached over the cut out portion (window 20') of the spine 18, in Figures 1-3 embodiments.

With respect to claims 10, 12 and 24-26 and the material of the transparent window and display box , see column 4, lines 61-65.

The foldable case of Weavers '863 is inherently capable of storing a toy.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weavers '863. Weavers '863 as described above discloses all the limitations of the claims except for the exact dimensions of the foldable case. Weavers in column 3, lines 3-10 discloses that different cassettes of varying format can be stored in the foldable case. Therefore, it would have been an obvious matter of design choice to modify the shape and size of the foldable case to accommodate varying size cassettes, since such

a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

12. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco '575 in view of Becker et al. (4,597,743). Blanco '575 discloses as described above discloses all the limitations of the claims except for the foldable case including a booklet that is a toy. Becker '743 discloses that it is desirable to make booklets as toys to make them more pleasing to the children. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a toy booklet instead of the booklet of the foldable case of Blanco '575 as taught by Becker '743 to make the foldable case and booklet more pleasing to the consumer.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weavers '863 in view of Leverence (2,619,168). Weavers '863 as described above discloses all the limitations of the claims except for the transparent window being a meshed screen. Leverence '168 discloses that it is desirable to provide a mesh screen to a window opening to permit ventilation without the admission there into of unwanted objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a mesh screen to the window opening of Weavers '863 as taught by Leverence '168 to allow ventilation without the admission there into of unwanted objects into the foldable case.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are foldable cases analogous to applicant's instant invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

**JILA M. MOHANDESI  
PRIMARY EXAMINER**

  
Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
December, 10, 2003